

REMARKSRejection of Claims of Art Grounds in the 13 January 2005 Office Action, and
Traversal Thereof

In the 13 January 2005 Office Action, claims 1-38 stand rejected under 35 U.S.C. 102(e) as being anticipated by Endo (U.S. Patent No. 5,974,392).

The above rejections of the claims 1-38 are traversed, and consideration of the patentability of claims 1-38 as amended, is requested in light of the ensuing remarks.

The Present Invention Is Novel Over Endo (U.S. Patent No. 5,974,392)

As stated in MPEP §2131, a claim is anticipated under §102 only if each and every element as set forth in the claim, in as complete of detail, is found in a single prior art reference. The claimed invention, according to the currently amended independent claims, includes recitations for improving the profiles of the resources using data mined from the generated plan. Endo does not disclose the above underlined limitation.

Therefore, Endo cannot anticipate the present invention as presently claimed. Support for the current amendments can be found as original in paragraphs [0010], [0175], and [0176] of the present application. Therefore, no new matter has been added by this amendment.

The Present Invention Is Not Obvious Over The Cited References

A claimed invention may be found to have been obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). Moreover, the Federal Circuit has ruled on numerous occasions that a holding of

"obviousness" requires some motivation, suggestion or teaching within the cited references that would lead one skilled in the art to modify the cited reference or references as claimed by applicant. See, for example, *In re Kotzab*, 217 F3d 1365, 55 USPQ2d 1313 (Fed Cir. 2000):

"Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)."

The cited Endo patent describes a software tool useable with Workflows. The present invention also discloses a software tool useable with Workflows. However, the software tool of the present invention as specifically claimed is novel and non-obvious over the cited references. Neither the Endo patent nor the patents cited but not applied suggest or teach alone or in combination a method in a data processing system having a workflow that models a process that includes a step of improving the profiles of a plurality of resources using data mined from a generated plan. Nor does the cited prior art teach or suggest alone or in combination a computer-readable medium containing instructions for controlling a data processing system, the data processing system having a workflow that models a process and a plurality of plans generated from the workflow that reflect instances of the process, wherein the instructions include a step of improving the profiles of a plurality of resources using data mined from a generated plan. Accordingly, the claimed invention as a whole cannot be properly held to be obvious.

CONCLUSION

In view of the foregoing, claims 1-38 constituting the claims pending in the application, are submitted to be fully patentable and in allowable condition to address and overcome the rejections.

If any issues remain outstanding, incident to the allowance of the application, Examiner Barqadle is respectfully requested to contact the undersigned attorney at (919)-664-8222 or via email at jinang@trianglepatents.com to discuss the resolution of such issues, in order that prosecution of the application may be concluded favorably to the applicant.

This response is submitted to the USPTO via USPS Express Mail on _____.

Respectfully submitted,



Jinan Glasgow #42585
MacCord Mason, PLLC
PO Box 28539
Raleigh, NC 27611-8539
919-664-8222
919-664-8625 (fax)

CERTIFICATE OF TRANSMISSION

I HEREBY CERTIFY THAT THIS DOCUMENT IS
BEING FACSIMILE TRANSMITTED TO THE
PATENT AND TRADEMARK OFFICE (FAX NO.
(703) 872-9306) TO: EXAMINER Bargadie, Yasjin,
ART UNIT 2153

ON APRIL 11, 2005
(Date of Deposit)

Christian E. Carter-Seyboth

Name of Depositor

Christian E. Carter-Seyboth

Signature